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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,520	06/18/2001	John C. Parsons	1931.VIN	2425
40256	7590	09/11/2006	EXAMINER SPERTY, ARDEN B	
FERRELLS, PLLC P. O. BOX 312 CLIFTON, VA 20124-1706			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,520

Applicant(s)

PARSONS ET AL.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/08/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### NON-FINAL OFFICE ACTION

1. The Double Patenting rejections of previously existing claims 1-14, in view of US Patents 6683129 and 6562892, both to Eknoian et al, are withdrawn, due to Applicant's submission of Terminal Disclaimers. The Terminal Disclaimers have been approved. Furthermore, the Declaration under 37 CFR 1.131 is not required to overcome the prior art rejection, due to Applicant's invocation of statute 35 USC 103(c). The statement of co-assignment under 103(c) is sufficient to withdraw the prior art rejections set forth in the last Office Action. Despite this advance, previously pending claims 1-4, and new claims 15-16 are currently rejected under 35 USC 112, first and second paragraphs (see below).

### *Information Disclosure Statement*

2. The IDS submitted 5/08/06 has been considered. Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. **It is to be noted, however, that consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search.** See MPEP 609, at page 600-125, Revision 2, May 2004. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been

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considered by the examiner to the extent noted above. In the present instance, the submitted references have not been described with respect to the claims to permit consideration of such a description.

3. The related cases listed on page 1, section "Other Documents" of the IDS are not appropriate for an IDS, as application serial numbers are not printed on issued patents, should the current application pass to issue.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following comments apply to all pending independent claims, since all pending independent claims suffer the same deficiencies.

6. The claims recite an emulsion binder comprising a polymer. The claims require certain properties: The emulsion binder has specific dispersibility properties; the polymer has a T<sub>g</sub> within the claimed range. The specification teaches various monomers suited for making said polymer. However, the specification is not adequately enabled for producing the polymer component having the required properties, because

not all of the monomer combinations that fall within the scope of the claims necessarily result in a polymer having the claimed properties.

7. While the specification may list suitable monomers, the specification is not enabled for producing the claimed polymer having the required properties. It has been held that "laundry list" style chemical disclosures do not constitute a written description of all possible combinations of the listed moieties. See MPEP 2163, and *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996). The lists of possible monomers would not reasonably lead one of ordinary skill in the art to a polymer having the required Tg property.

8. To the above point, it is further notable that the compositional ranges of the monomers are so broad that they do not provide guidance as to suitable combinations meeting the polymer property requirements. Firstly, the hydrophilic monomer is disclosed and claimed in an amount of 1 to 100 wt%. Secondly, the non-hydrophilic monomer is disclosed and claimed in an amount of 0 to 99%. Thirdly, the monomers are claimed using "comprising" language, meaning that the scope of the claim is so broad as to include any other additives or components which may or may not affect the properties of the resultant polymer. Thus the unpredictability of a resulting polymer is further complicated. The breadth of the claims places an unreasonable burden of experimentation, even on one familiar with the art.

9. The specification does not provide adequate description of a working polymer composition, except for a first composition as set forth in Examples 1-2, and 4-8 (same

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composition in all working examples) and a second composition as set forth in Example 3. The composition of Example 3 is very similar to the first composition (Examples 1-2, and 4-8). These limited working examples are not sufficient to guide one of ordinary skill in the art to make other suitable polymer compositions out of any of the other listed monomers and combinations thereof, nor with monomers in other proportions still within the broad scope of the claim. In view of this and the above points, it can be concluded that one of ordinary skill in the art would be required to perform extensive and undue experimentation in order to figure out what would meet the claim limitations.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The claims are indefinite because they fail to sufficiently recite structure and/or chemistry of the polymer that produces the desired tap water dispersibility and non-dispersibility in an emulsion binder.

13. The claims are further indefinite because Section b) of claim 1 is not clear as to whether or not the polymer itself has salt sensitive dispersibility, or whether or not the polymer contributes to the salt sensitive dispersibility of the emulsion binder. Specific attention is drawn to Claim 1, the first line of section b), stating "an emulsion binder

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comprising a tap water-dispersible polymer which is non-dispersible in . . . " (emphasis added). It is not clear if "which" refers to the emulsion binder or to the polymer.

### ***Conclusion***

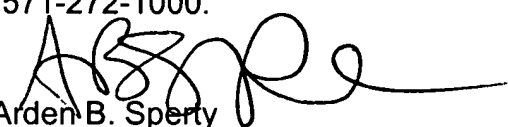
14. This office action is made Non-Final due to the new grounds of rejection under 35 USC 112, first and second paragraphs. No prior art is currently applied because of the degree of non-enablement and indefiniteness.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arden B. Sperty  
Examiner  
Art Unit 1771



CHERYL A. JUSKA  
PRIMARY EXAMINER

August 31, 2006